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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,457	03/15/2002	Helena Leppakoski	3397-114PUS	3030
7590	01/26/2004			
Michael C Stuart Cohen Pontani Lieberman & Pavane Suite 1210 551 Fifth Avenue New York, NY 10176			EXAMINER NGUYEN, JIMMY T	
			ART UNIT 3725	PAPER NUMBER 8
DATE MAILED: 01/26/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,457

Applicant(s)

LEPPAKOSKI ET AL.

Examiner

Jimmy T Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

Specification

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “air-jet cutting device” (claims 6, 12, 13) and “a decision making algorithm” (claims 6-7) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims call for a method

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and an apparatus for opening the nip of a calender. However, the claim and the specification do not disclose how the nip is being opened, and means for opening the nip.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are generally narrative and indefinite, failing to conform with current U.S. practice. The claims are drafted in a narrative and confusing syntax which would hinder one skilled in the art in determining when infringement might occur. Claims 1-6 and 14 do not positively set forth method steps intended to be claimed. For example, in claim 1, it is not clear whether the method step of "especially for performing the nip opening at a break.." is intended to be a positively recited step or not. It is suggested that the words "comprising the steps of" should follow the preamble of the claim. Applicant should carefully review and amend the claims to put them in proper form for US practice.

Regarding claims 2-6, it is unclear of what method step applicant refers to.

Regarding claim 7, the claim is functionally indefinite in that it does not recite sufficient structure to properly support the functional language. The claims are basically considered totally incomplete in that they do not define sufficient structure to accomplish the intended results. The claim recites only two members, and a gauging device. There is no further positive recitation of any further structure. Without further elements, the functional language (i.e. opening the calender nips) is vague, unclear, and clearly indefinite. The element(s) that provided the opening for the calender nips must be recited.

Regarding claim 7, lines 7-8, it is unclear whether a gauging device being calendered or the web being calendered. Additionally, the claim is indefinite in that they fail to positively recite the critical interrelationships between the elements. For example: there is no positive recitation of any critical interrelationship between the gauging device and the two members.

Regarding claim 7, line 12, the word "adapted openable" is needlessly confusing because it suggests possible uses instead of positively reciting a functional relationship. As result, the claims are vague and functionally indefinite.

Regarding claim 14, line 3, it is not clear what is meant by "the machine-direction tension of the web"

The claims appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. All of the claims should be reviewed for clarity, definiteness, antecedent basis concerns and proper recitation of critical interrelationships.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 7-11, 14, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Safman et al. (US 6,158,334), in view of Rantala (US 5,052,233).

Regarding claims 1, 5, 7, 10-11, and 14, Safman discloses a method and an apparatus for opening the nip of a calender comprising: a hard roll (22), a soft roll (10), a gauging device (99)

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for detecting a break of moving web (80). Safman discloses one of the rolls (22) moves away from the other roll as soon as the gauging device (99) detects a break of the web. Safman discloses the break of the web is detected by the gauging device such as optical sensors (col. 11, line 6). Safman further discloses that any existing different solutions may be used for achieving the gauging device (99), for detecting if the fiber web is broken (col. 11, lines 3-5). The Rantana reference is an example of one of many existing different solutions for detecting if the web is broken. Rantana discloses a web tension measurement apparatus (fig. 2) as a gauging device for detecting web breaks (col. 1, lines 24-25), wherein the gauging device is a gauging bar having an arcuate surface (fig. 2) and pressure sensors (2, 3, 12, 13). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace Safman's gauging device, with the type of web tension measurement gauging device, as taught Rantana, so as to detect web breaks.

Regarding claims 8 and 9, Safman discloses the gauging device is located at a point preceding a calender nip. As to the gauging device is located at a point after the calender nip, it would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the gauging device from the point preceding a calender nip to the point after the calender nip, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Additionally, the disclosure does not state any advantage for this limitation.

Claims 6, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safman et al. (US 6,158,334), and Rantala (US 5,052,233), as applied to claim 7 above, further in view of Enwald et al. (US 6,293,175). Salman disclosed the invention substantially

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as claimed as set forth above except for a cutting device for cutting the web after a web break has been indicated. The patent to Enwald, in a related calendering art, teaches that it is old and well-known in the calendering art to provide a calender machine with a cutting device (fig. 2) for cutting off a web (W) when an uncontrolled web break takes place in the machine (col. 1, lines 9-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Safman with a cutting device, as taught by Enwald, to cut off the web when a broken web is detected, in order to protect other components from being damaged (col. 1, lines 14-18).

As to the cutting device is an air-jet cutting device, Enwald discloses that the type of air-jet cutting device is best when use for cutting thin paper grades, and problems arise when using pressurized air to cut thicker paper grades (col. 1, lines 45-59). Therefore, it is a matter of design choice to use air jet as a cutting device, and one skilled in the art at the time of the invention was made would make a choice dependent on the type material (i.e. paper/web grades) that is cut.

Please note that claims 2-4 have not been rejected over prior art. However, in view of the issues under 35 USC 112 rejections as set forth above, the allowability of the claims can not be determined at this time.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy T Nguyen whose telephone number is (703) 305-5304. The examiner can normally be reached on Mon-Thur 8:00am - 6:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen Ostrager can be reached on (703) 308-3136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

JTNguyen
January 21, 2004



ALLEN OSTRAGER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700